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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/658,381	09/10/2003	Kiyoshi Miyake	S0529.0006	3331
32172	7590	04/04/2006	EXAMINER	
DICKSTEIN SHAPIRO MORIN & OSHINSKY LLP 1177 AVENUE OF THE AMERICAS (6TH AVENUE) 41 ST FL. NEW YORK, NY 10036-2714			LEUBECKER, JOHN P	
			ART UNIT	PAPER NUMBER
			3739	
DATE MAILED: 04/04/2006				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/658,381	<b>Applicant(s)</b> MIYAKE, KIYOSHI	
	<b>Examiner</b> John P. Leubecker	<b>Art Unit</b> 3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2006.
- 2a) ☐ This action is **FINAL**.      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 21-24 and 28-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-24 and 28-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
- ☒ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

***Specification***

1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

***Claim Objections***

2. Claims 23 and 33 are objected to because of the following informalities: as to claim 23, "of the base" (line 6) should be removed since such was removed in claim 21; as to claim 33, recitation of both a "four- *and* eight-directional" instruction key is improper, not only because it is not clear how it can be both at the same time, but because the specification only covers one *or* the other. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 21-23, 29 and 30 are rejected under 35 U.S.C. 102(b) as being anticipated by Rossoff (U.S. Pat. 5,183,031).

Rossoff discloses a flexible slender insertion section comprising a slender flexible tube (proximal end of 12) which inherently has a proximal and distal portions, a bendable portion (distal end of 12) and a distal portion (18), an operation section coupled to the insertion section

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and having a grip portion (24), a bending operation portion (22) and a display portion formed of a display panel (30) which displays the observation image, the display panel provided on a frame (the inherent structure surrounding the optics of the optical head and including the focusing ring 34) integrally attached to the grip portion (note stem 32, Fig.1). The insertion section has a channel (16) which opens at the distal end and has a proximal open end formed by a port (38) (forceps-port constructing member) provided on a grip end of the grip portion (note Figs. 1 and 3). As to claim 22, note grip portion (24). As to claim 23, grip portion (24) has a casing (24, Fig.1) and a forceps port constructing member (38) which inherently is coupled to the proximal open end of which it surrounds. As to claim 29, a tube which is inherently connected to port (39) (oxygen port, col.3, lines 3-7) would constitute a "universal cable" and would extend in the same direction as the opening of the forceps-port constructing member (38) since these ports are side-by-side. As to claim 30, lever (22) would constitute as "joystick" in its broadest interpretation.

5. Claims 21, 22, 24 and 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Adair (U.S. Pat. 5,873,814).

Referring mainly to Figure 20, Adair discloses a flexible slender insertion section as claimed (note that only distal portion 310,320 is enumerated but also includes a bending portion (portion shown in a U-shape and in dashed lines in Figure 20) and a flexible tube portion (portion between the bending portion and operating portion 340); Adair refers to U.S. Pat. 5,489,256 regarding further description), an operating section (340) coupled to the proximal end of the insertion section having a grip portion (outer housing of operating section including

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portion for attachment to the display 330), a bending operation portion (note rotary knob in Figure 20; labeled as (100) in Figure 6 of U.S. Pat. 5,489,256) for bending the bendable portion and a display portion formed of a display panel (332) provided on a frame (331) integrally attached to the grip portion. The insertion section has a channel (325) with open distal end (at the distal end of the device, note col.14, lines 21-25) and proximal open end (proximal end of tube 325 which is better shown in Figure 6 of the '256 patent with an instrument 112 inserted) which is provided on (note 110, Fig.6 of the '256 patent) the grip portion (that area being considered the grip end).

### *Claim Rejections - 35 USC § 103*

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 30-32 are rejected under 35 U.S.C. 103(a) as being unpatentable over Rossoff et al. in view of Ohline et al. (US 2003/0045778) and separately over Adair ('814) in view of Ohline et al.

Rossoff et al. discloses a lever (which can be considered a joystick or a rotary knob, since it rotates around a pivot axis) and Adair discloses conventional rotary knobs. Thus, each of these references fail to disclose other known bending mechanisms. Ohline et al. teaches that it is known to use other bending mechanisms beside rotary knobs, including a joystick, a trackball

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and a trackpad ([0054]). It would have been obvious to one of mere ordinary skill in the art at the time of the invention to have used any one of the known bending mechanisms taught in the art since each have been contemplated, they would provide an equivalent function (i.e. induce bending) and would have been obvious for their intrinsic advantages.

8. Claim 33 is rejected under 35 U.S.C. 103(a) as being unpatentable over Rossoff et al. in view of Ohline et al. and further in view of Suzuki et al. (U.S. Pat. 5,658,238) and separately over Adair ('814) in view of Ohline et al. and further in view of Suzuki et al.

The modifications described above still fail to mention push buttons. However, Suzuki et al. demonstrates that four-directional (e.g. Fig.76) and eight-directional (e.g., Fig. 88) push buttons (as well as a joystick, Fig.52) are known and have been contemplated for use as a bending mechanism on an endoscope. It would have been obvious to one of ordinary skill in the art to have provided any known and contemplated mechanism for bending and endoscope on the devices of Rossoff et al. and Adair without involving inventive concept since have been thought of and provide equivalent functions (i.e., induces bending).

### ***Response to Arguments***

9. Applicant's arguments filed February 1, 2006 have been fully considered but they are not persuasive.

### ***Conclusion***

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10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Adair (U.S. Pat. 5,489,256)

Smith et al. (US 2002/0022769)

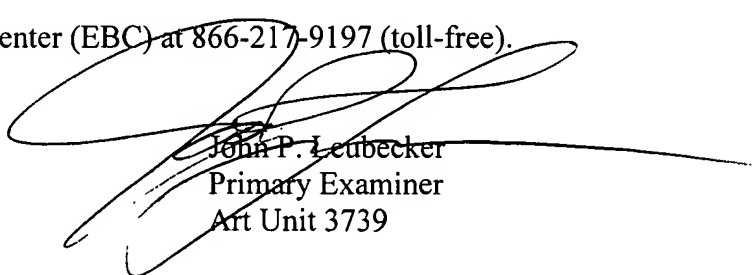
Adachi (U.S. Pat. 5,531,664)

Mizuno et al. (U.S. Pat. 6,569,084)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Leubecker whose telephone number is (571) 272-4769. The examiner can normally be reached on Monday through Friday, 6:00 AM to 2:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda C.M. Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker  
Primary Examiner  
Art Unit 3739

jpl